

REMARKS

The first sentence after the title has been amended to specifically reference the earlier filed applications to which the captioned application claims priority benefit from.

It is submitted that no new matter has been introduced by the foregoing amendments. Approval and entry of the amendments is respectfully solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made."

It is noted with appreciation that the Examiner has removed the objections to the specification and to the claims.

Anticipation Rejection

Claim 1 was rejected under 35 USC §102(b) as anticipated by Ginocchio., US Patent No. 4,237,591("Ginocchio"). (Paper No. 5 at 3.)

For the reasons set forth below, the rejection, respectfully is traversed.

Ginocchio discloses a sanitary napkin that is provided with a perfume. (Col. 2, lns. 24-29.) The perfume is made of a formulation having an essential oil, solvents, and other additives designed to provide the perfume with desired properties. (Col. 2, lns. 38-41.) The amount of perfume used was disclosed as being 0.02 to 0.08 g/napkin. (Col. 5, lns. 19-22.) A particular mini-pad was disclosed as weighing about 3 g. (Col. 6, lns. 21-28.)

In making the rejection, the Examiner maintained the rejection "essentially for the reasons given previously" in the October 24, 2001 Office Action. (Paper No. 5 at 3.) In that Office Action, the Examiner contended that "Ginocchio discloses sanitary napkins provided with a liquid perfume which comprises essential oils, solvents and other additives. Please see col. 2, lns. 39-41." (Paper No. 3 at 4.)

There is a "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103...." *In re Warner*, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). Furthermore, "it is incumbent upon the Patent Office ... to set forth clearly why it regards a claim to be anticipated" *In re Mullin*, 179 USPQ 97, 100 (CCPA 1973).

The Record was Mischaracterized

The Examiner asserted that "Applicant contends that Ginocchio does not disclose a sanitary napkin containing an essential oil in an effective amount to provide for both a

pleasant aroma and an antimicrobial effect in order to inhibit antimicrobial growth.” (Paper No. 5 at 3.)

With all due respect, the record does not reflect as much as the Examiner asserted. The undersigned stated in Paper No. 4 that “[T]he Examiner failed to show where in Ginocchio there is a disclosure that the essential oil disclosed therein was in an effective amount to provide an aroma and to inhibit microbial growth.” (Paper No. 4 at 4-5.) (Emphasis added.) The statement on record made by the undersigned is very different from the Examiner’s assertion made in Paper No. 5.

As stated in Paper No. 4, it is well settled, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). The Examiner is required to point to the disclosure in the reference “by page and line” upon which the claim allegedly reads. *Chiong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990).

In Paper No. 3, the Examiner merely pointed to col. 2, Ins. 39-41, to support the anticipation rejection. However, as pointed out in Paper No. 4, the particular disclosure pointed out by the Examiner did not satisfy the Examiner’s burden.

In fact, the Examiner was asked in Paper No. 4 to point out where there was a disclosure of liquid perfume because no such disclosure could be found in the section relied upon by the Examiner. The Examiner responded to this query by specifically identifying “column 2, lines 18-27” for such disclosure. (Paper No. 5 at 3.) This passage is NOT the same disclosure relied by the Examiner to make the original rejection. The record is not clear as to where in Ginocchio the Examiner is relying upon to make the rejection. Because the Examiner has not met this minimum requirement for establishing a rejection under 35 USC § 102, the rejection is improper and should be withdrawn.

“May be Inherent” is not a ground for Anticipation

In the Final Office Action, for the first time in this record, the Examiner asserted that “the amounts of essential oil in the prior art may inherently contain the claimed antimicrobial function.” (Paper No. 5 at 4.)

As is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir.

1984). Indeed, as the Federal Circuit has stated: “[t]he limitations which must be met by an anticipatory reference are those set forth in each statement of function. . . . Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept.” *RCA Corp. v. Applied Digital Data Sys., Inc.*, 221 USPQ 385, 389 n.5 (Fed. Cir. 1984)

It is submitted that “may be inherent” in NOT an assertion that each and every element of the claim is found in Ginocchio. In fact, it appears that the Examiner questions whether such disclosure is actually inherent in the cited document. Thus, the requisite burden placed on the Examiner has not been met. For this additional reason the rejection is improper and should be withdrawn.

Not Required to Distinguish of Ginocchio

The Examiner appears to have required argumentation of how “the amount of essential oil disclosed in the specification “is not disclosed or distinguished over the amount disclosed in the prior art.” (Paper No. 5 at 4.) However, rebuttal evidence is not required where the Examiner failed to satisfy the minimum requirements to make a proper case of anticipation. The record made by the Examiner in this case does not contain the requisite facts to make such a case of anticipation. Therefore, it is submitted that the burden has not shifted from the Examiner and the rejection should be withdrawn.

Additionally, the Examiner asserted that “[s]ince Applicant is claiming amounts functionally, one of ordinary skill in the art must turn to the specification.” With all due respect, mere functional language in a claim is not reason in and of itself to resort to the specification to determine the metes and bounds of the subject matter being claimed.

Obviousness Rejection

Claims 19-23 and 6-11 were rejected under 35 USC §103(a) as being unpatentable over Ginocchio, in view of Engle, US Patent No. 3,819,405, (“Engle”) and Hooper, US Patent No. 4,343,783 (“Hooper”). (Paper No. 3 at 4.)

For the reasons set forth below the rejection, respectfully is traversed.

Ginocchio’s disclosure set forth above is incorporated herein by reference.

Engle discloses impregnating water insoluble synthetic resins with a volatile substance, e.g., an essential oil. (Col. 2, Ins. 17-21.) Engle discloses that the essential oil include oils of various fruits, e.g., apple, cherry, pineapple, etc., oils of various woods, e.g., cedar, pine, briar, and the like, oils of various flowers, e.g., roses, violets, tobacco flowers, and the like, and other such fragrances, e.g., peppermint, menthol, camphor, methyl

salicylate, eucalyptus, parachlor benzenes, acetates, and in general those essential oils, i.e., hydro carbons, alcohols, aldehydes, esters, terpenes, tars, phenols, thymols, etc. (Col. 3, lns. 26-37.) The essential oil was disclosed as being an emulsion containing a surfactant. (Col. 3, lns. 38-40.) Engle further discloses that an antimicrobial agent, which can be readily impregnated into a preformed synthetic resin by the emulsion method described in 2-ethyl hexyl salicylate. (Col. 6, lns. 38-40.) An example of an emulsion having purported medical or therapeutic effect was disclosed as having 20 parts of an essential oil, 5 parts of surfactant, 3 parts 2-ethyl hexyl salicylate, and 150 parts water. (Col. 6, ln. 58 – col. 7, ln. 2.) 2-ethyl hexyl salicylate was disclosed as being an anti-microbial agent. (Col. 7, lns. 15-27.) Engle discloses that such an emulsion, e.g., essential oil, surfactant, and 2-ethyl hexyl salicylate can be used in sanitary napkins. (Col. 7, lns. 28-32.)

Hooper discloses a deodorant disposable porous article having a porous substrate with from about 0.001 to 10 % by weight of a deodorant composition. (Col. 1, lns. 41-45.) The deodorant composition includes from 45-100% by weight deodorant components, which are classified into six classes. (Col. 1, lns. 45-58.) Class 2 was disclosed as including essential oils. (Col. 1, ln. 53.) Sanitary napkin covers and pads were disclosed as being an example of a disposable porous article. (Col. 10, lns. 53-62.)

In making the instant rejection, the Examiner maintained the rejection “essentially for the reasons given previously” in the October 24, 2001 Office Action. (Paper No. 5 at 3.) In that Office Action, the Examiner contended that “Ginocchio discloses sanitary napkins provided with a liquid perfume which comprises essential oils, solvents and other additives. Please see col. 2, lines 39-41.” (Paper No. 3 at 5.) The Examiner acknowledged, however, that Ginocchio differs from the presently claimed invention in that Ginocchio does not disclose “Applicant’s claimed essential oils (claim 20).”

To fill the acknowledged gap, the Examiner relied upon (1) Engle as disclosing “impregnating sanitary napkins with essential oils, such as cedar oil, so as to provide a pleasant fragrance” and (2) Hooper as disclosing deodorant disposable porous articles, such as sanitary napkins and their covers, wherein these napkins and covers are impregnated with essential oils comprising clove leaf oil, thyme oil, and cedar atlas oil.” (Paper No. 3 at 5.)

The Examiner then concluded that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sanitary napkin of Ginocchio by impregnating the napkin with essential oils like cedar oil, thyme oil, or clove oil as taught by Engle and Hooper because one of ordinary skill in the art would reasonably expect the

resulting sanitary napkin to suppress or eliminate any malodors associated with the use of a sanitary napkin." (Paper No. 3 at 5.)

With respect to the claimed concentration of essential oils, the Examiner concluded that "it would have been obvious to one of ordinary skill in the art to further modify the sanitary napkins of the prior art to provide a concentration of essential oils sufficient to eliminate odors" "since pleasant aromas are often associated with the amount of essential oil present."

Moreover, the Examiner concluded that the use of rosemary oil would have been obvious and "well within the capability of the skilled artisan."

The Examiner also concluded that "determining the location where the essential oil is contained in the sanitary napkin is obvious and well within the capability of the skilled artisan." The Examiner further concluded that "one of ordinary skill in the art would be motivated to place the essential oils in an area that would provide for optimum elimination of malodorous substances." (Paper No. 3 at 6.)

There is a "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. . ." *In re Warner*, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner was required to demonstrate *where* in the cited references there is a suggestion that would have "strongly motivated" one to make a sanitary napkin as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1986). The type of motivation which would have "*impelled*" one to do so (*Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993)), and the type of suggestion that the changes "*should*" be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Obviousness, however, cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. As is fundamental, a *prima facie* case of obviousness must be based on facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (CCPA 1970). When a conclusion of obviousness is not based upon facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993).

The statements presented above with respect to traversing the anticipation rejection apply to the obviousness rejection, as well. Therefore, such statements are incorporated herein.

The Record was Mischaracterized

The Examiner asserted that “Applicant contends that Engle and Hooper do not cure the deficiencies of Ginocchio because they, too, do not teach an effective amount of essential oil to inhibit microbial growth.” (Paper No. 5 at 4.) However, the record specifically states that “the Examiner failed to show where in Ginocchio, Engle, and Hooper there is a disclosure, suggestion or motivation of, among other things, an effective amount of essential oil to provide aroma and to inhibit microbial growth.” (Paper No. 4 at 6-7.) For this reason, the Examiner has mischaracterized the record.

Examiner May Not Pick and Choose Parts of a Reference

In response to the position set forth in Paper No. 4, namely that “Engle specifically teaches away from the claimed invention” (Paper No. 4 at 7), the Examiner asserted that “the Examiner relied upon Engle for the teaching that the use of cedar oil in sanitary napkins is disclosed.” (Paper No. 5 at 5.) However, binding precedent makes it clear that one “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596 (Fed. Cir. 1988).

Yet, it appears that the Examiner has done precisely what such case law cautions against doing. That is, pick and choose which parts of Ginocchio to rely to make the instant rejection. Such practice is tantamount to hindsight reconstruction. It is submitted that the Examiner cannot ignore the disclosure in Engle that an additional component, 2-ethyl hexyl salicylate, is added as an antimicrobial agent for use in sanitary napkins in making the instant rejection. Because it appears that the Examiner has used hindsight reconstruction, the rejection is improper and should be withdrawn.

“May have” is Wrong Standard for Obviousness

The Examiner asserted for the first time in the Final Rejection that “the amounts of essential oil in the prior art may have an antimicrobial effect.” Such reasoning indicates that the Examiner is asserting that the essential oils disclosed in the various documents in the record would be obvious to try to determine whether they have an antimicrobial effect. However, obvious to try is not the standard of 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). For this reason, the Examiner has failed to meet the minimum requirements to make out a prima facie case of obviousness.

Not Required to Distinguish over Cited Documents

The Examiner appears to have required argumentation of how the amount of essential oil disclosed in the specification "is not disclosed or distinguished over the amount disclosed in the prior art." (Paper No. 5 at 5.) However, there is no requirement for rebuttal evidence absent the Examiner meeting the minimum burden to make a *prima facie* case of obviousness. The record in this case does not contain such factual allegations by the Examiner. Therefore, it is submitted that the burden has not shifted from the Examiner and the rejection should be withdrawn.

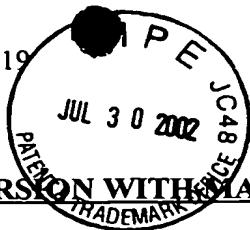
Accordingly, for the reasons set forth above, entry of the amendments, withdrawal of the rejections, and allowance of the claims is respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

Respectfully submitted,

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Serial No. 09/900,319



VERSION WITH MARKINGS TO SHOW CHANGES MADE

TECH CENTER 1600/2000

RECEIVED
AUG 07 2002

In the Specification:

The sentence at page 1, line 3, was replaced with the following rewritten paragraph:

-- This is a division of Application No. 09/320,975, which issued as U.S. Patent No. 6,284,261, which claimed priority under 35 USC § 119(e) to 60/088,962, abandoned.